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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,183	05/23/2000	Paul Lapstun	NPK002US	9150
24011	7590	12/03/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			TRAN, TONGOC	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/575,183	Applicant(s) LAPSTUN ET AL. 	
	Examiner Tongoc Tran	Art Unit 2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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### **DETAILED ACTION**

1. This Office Action is in response to Applicant's Request for Continued Examination (RCE) filed on 8/23/2004. Claim 1 has been amended. Claim 8 has been cancelled. Claims 1-7 are pending.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Debry (U.S. Patent No. 6,314,521, hereinafter Debry ['521]) in view of Newton et al. (U.S. Patent No. 5,771,291, hereinafter Newton) and further in view of Tatebayashi (U.S. Patent No. 6,654,883).

In respect to claim 1, Debry ['521] discloses "a network connectable to a printer and a registration server, a network registration protocol for registering the printer on the network, including the steps of

installing a secret unique identifier in the printer and in a database of the registration server, before the printer is connected to the network (see col. 8, lines 56-64);

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transmitting unique identifications of the printer to the registration server and receiving the unique identification in the registration server, when the printer is connected to the network (see col. 6, lines 36-43); and

Debry discloses authenticating the printer to the server by comparing the unique identifier sent from the printer in encrypted form and in clear using printer's encryption key stored in the server's database to decrypt the encrypted unique identifier. Debry does not explicitly disclose said identifier is a unique secret identifier and is used by the server to compare with the unique secret identifier of the printer stored in the server's database in order to authenticate the printer. However, Newton discloses a user sends a unique identification key from a CD-ROM Disk to a server and the server decrypts the unique identification key and compare said key with what is stored in the server database and verifies the user's identity (see Newton, col. 4, lines 9-27). Furthermore, Tatebayashi discloses a device authentication and encrypted communication system between plurality of user devices and a system device. The user device transmits a piece of key capsule data (encryption key) to the system device (see Tatebayashi, col. 3, 17-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Debry's authenticating the printer by comparing printer unique identifier sent in encrypted form and in clear using printer's encryption key stored in the server to decrypt the encrypted message with the teaching of Newton's teaching of authenticating a user identity by comparing user to the one stored in the server's database to prevent user from sharing password (Newton, col. 1, lines 9-20) with

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Tatebayashi's authentication between plurality of user devices with system device to confirmed the legitimacy of the other to ensure security of valuable data is protected from tampering by third party while being sent on the communication path (Tatebayashi, col. 1, lines 10-22).

In respect to claim 2, Debry ['521], Newton and Tatebayashi disclose the network registration protocol according to claim 1, including the further step of holding unique secret identifier in non-volatile memory in said printer together with a public unique identifier (see Debry, col. 9, lines 15-23)

3. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Debry (U.S. Patent No. 6,314,521) hereinafter Debry ['521] in view of Newton et al. (U.S. Patent No. 5,771,291, hereinafter Newton) and Tatebayashi (U.S. Patent No. 6,654,883) and further in view of Debry (U.S. Patent No. 385,728) hereinafter Debry ['728]

In respect to claim 3, Debry ['521], Newton and Tatebayashi disclose the network registration protocol according to claim 2, including the further step of "creating a public key together with its paired private key in said printer". However, Debry ['728] discloses an encryption key can be generated in a printer (see col. 10, lines 12-19). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement of the teaching of Debry ['728] to generate key in the printer instead of generate the key by the printer's manufacture as taught by Debry ['521] for better protection of the key from the third party like the manufacture of the device.

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In respect to claim 4, Debry ['521], Newton, Tatebayashi and Debry ['728] disclose the network registration protocol according to claim 3. Debry ['728] further discloses a printer sending a request with the printer's public key to the file server (col. 13, lines 49-53, col. 13, line 65-col. 14, line 2).

In respect to claim 5, Debry ['521], Newton, Tatebayashi and Debry disclose the network registration protocol according to claim 4. Debry ['521] further discloses the step of testing the received secret unique identifier and public unique identifier in the remote registration server to verify the identity of the printer (see col. 8, line 65-col. 9, line 35).

In respect to claim 6, Debry ['521], Newton, Tatebayashi and Debry ['728] disclose the network registration protocol according to claim 5. Debry ['521] further discloses "said printer obtaining said registration server's certificate, authenticating it with reference to a certificate authority, using a public key-exchange key in said certificate to exchange a secret session key with the server, and then use said secret session key to encrypt said transmission (see col. 9, lines 15-34).

In respect to claim 7, Debry ['521], Newton, Tatebayashi and Debry ['728] disclose the network registration protocol according to claim 6. Debry ['521] further discloses " in the event the printer's identity is verified, of creating and signing a certificate containing said printer's public unique identifier and public signature key, in said server; and storing the printer's certificate in a database for retrieval by third parties wishing to exchange data with the printer" (see col. 6, lines 52-64, col. 5, line 65-col. 6, line 12).

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Chan et al. Disclose a secure printing system in a distributed computing environment.

-Lee discloses a Java printer for printing documents base on java commands.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Tongoc Tran  
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TT



November 22, 2004



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SUPERVISORY PATENT EXAMINER  
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